

### **REMARKS**

Applicant respectfully requests reconsideration and allowance of claims 1-10 that are pending in the above-identified patent application. In view of the following discussion, Applicant submits that all pending claims are in condition for allowance.

At pages 2-4 of the Office Action, the Examiner rejected claims 1-7, 9, and 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,947,118 (“the ‘118 patent”) in view of U.S. Patent No. 5,871,010 (“the ‘010 patent”), and further in view of U.S. 5,472,143 (“the ‘143 patent”). At page 5 of the Office Action, the Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over the ‘118 patent, the ‘010 patent, the ‘143 patent, and further in view of U.S. 4,889,114 (“the ‘114 patent”). Applicant respectfully traverses the Examiner’s rejections.

Claims 1-10 recite “a plurality of cells having elevations and/or depressions in a repeating pattern of an egg-carton arrangement.” Neither the ‘118, ‘010, ‘143, nor ‘114 patents disclose this feature. The ‘010 patent specifically teaches that the elevations and/or depressions are in the form of grooves (col. 7, lines 9-19; and FIGS. 3-6). None of the other cited patents cures this deficiency in the ‘010 patent. Accordingly, the above-quoted features of independent claim 1 and the subject dependent claims are neither disclosed nor suggested by the cited art of record.

The ‘010 patent teaches away from employing egg-carton elevations and/or depressions. Indeed, Datta specifically teaches that the elevations and/or depressions are in the form of grooves. Datta also teaches “minimizing the area of contact between the medicament and the surfaces of the inhaler” to promote the release of the medicament from the inhaler (Abstract; col. 1, lines 35-38; col. 2, lines 55-57). On page 3 of the Office Action, the Examiner acknowledged this teaching stating, “...the grooves of Datta et al. are provided to *minimize* the area of contact in order to maximize the release of medicament...”. The ‘010 patent teaches away from increasing the surface area of contact between the medicament and the surfaces of the inhaler, which would occur if one skilled in the art employed the egg-carton elevations and/or depressions of the present invention instead of the parallel grooves of Datta. Indeed, egg-carton elevations and/or depressions, such as in the present invention, inherently have a greater surface area of contact with medicament than narrow grooves, such as in the ‘010 patent. Therefore, one skilled in the art would be discouraged from modifying a device in which surface area is to be minimized with egg-carton elevations and/or depressions based

on the teachings of the '010 patent. As such, Applicant submits that claims 1-7, 9, and 10 are patentable over the '118 patent, the '010 patent, and the '143 patent, alone or in combination.

The Examiner contends that because the grooves minimize the area of contact "it appears as though the modified device would perform equally well" with egg-carton elevations and/or depressions. Under MPEP § 2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." Additionally under MPEP § 2142, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." The Examiner does not present evidence supporting the subject allegation or a motivation to modify the device of the '010 patent to employ egg-carton elevations and/or depressions. Thus, the Examiner fails to present a *prima facie* case of obviousness. Applicant submits that no such evidence is apparent from the prior art to support the allegation that egg-carton elevations and/or depressions of the present invention would perform equally well as narrow grooves of the '010 patent. When reviewing prior art, the Examiner must take "into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure." *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). However, the Examiner is in fact looking to the disclosure of the present invention for facts rather than to the prior art because the prior art does not contain evidence to support the Examiner's allegation. Indeed, the prior art teaches away from employing egg-carton elevations and/or depressions. As such, Applicant submits that the Examiner is employing impermissible hindsight. See *W.L. Gore and Assoc. v. Garlock Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). As such, Applicant submits that claims 1-7, 9, and 10 are patentable over the '118 patent, the '010 patent, and the '143 patent, alone or in combination.

In view of the foregoing, Applicant submits that the combined teachings of the cited art fail to disclose all of the features of the invention as claimed in independent claim 1, or dependent claims 2-10 of the instant application, and thus the pending § 103(a) rejections should be withdrawn.

In view of the foregoing, Applicant submits that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited. The fee for the RCE is included herewith. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

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Respectfully submitted,

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